

### **REMARKS**

By this Amendment, Applicants have amended claims 1, 13, 22, 23, 25, and 37, and canceled claims 49-56 without prejudice or disclaimer of their subject matter. Applicants have also added new claims 57-64. The amendments to the claims are fully supported by the originally-filed application, for example, in the specification at page 14, lines 8-10 and lines 22-30, and Figs. 1-3, among other places. No new matter is introduced. Accordingly, claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 are pending.

#### **Summary**

In the Office Action<sup>1</sup>, the Examiner rejected claims 13, 16-24, 51, and 52 under 35 U.S.C. § 101, because the claimed invention is allegedly directed to non-statutory subject matter; and rejected claims 1, 4-13, 16-25, 28-37, 40-49, 51, 53, 55, and 56 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,422,821 to Allen et al. ("Allen") in view of a webpage for "NCOA Description" from www.anchorcomputer.com (Reference U of the PTO-892) ("Anchor").

#### **Rejection of Claims under 35 U.S.C. § 101**

Claims 13, 16-24, 51, and 52 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The rejection of claims 51 and 52 is rendered moot by virtue of the cancellation of these claims.

In the Office Action, the Examiner alleged that "[c]laims 13 and 51-52 [recite] various limitations regarding components. Software *per se* is not one of the recognized statutory classes of invention." Office Action, p. 3. The Examiner further alleged that "[c]laims 16-24 contain the same deficiencies through dependency." *Id.*

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<sup>1</sup> The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

Applicants submit that the Examiner has misinterpreted the claimed invention. Claim 13 recites “[a] system for resolving incorrect addresses,” which is not “software” when correctly interpreted in light of the specification. Although Applicants disagree with the Examiner’s allegation, for purposes of advancing prosecution, Applicants have amended claim 13 to recite “[a] system for resolving incorrect addresses, comprising: a storage device containing computer instructions; and a processor, connected to the storage device, that executes the computer instructions to perform operations comprising . . . .” Emphasis added. Applicants submit that the claimed invention is directed to statutory subject matter, i.e., “a new and useful . . . machine.” Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 101 rejection of claims 13 and 16-24.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 1, 4-13, 16-25, 28-37, 40-49, 51, 53, 55, and 56 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Allen in view of Anchor. Applicants submit that the rejection of claims 49, 51, 53, 55, and 56 is moot by virtue of the cancellation of these claims. Regarding the remaining claims, Applicants respectfully traverse this rejection. No *prima facie* case of obviousness has been established.

To establish a *prima facie* case of obviousness, the Examiner must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. See M.P.E.P. § 2144.08(II)(A), 8th Ed., Rev. 6 (September 2007). Furthermore, the Examiner must make findings with respect to all of the claim limitations and must make “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” See M.P.E.P. §§ 2143.03 and 2141(III).

Claim 1 recites a method for resolving incorrect addresses. The method includes, among other things, the following features:

receiving a first instance of an incorrect address associated with a first item, wherein the incorrect address does not match address information contained in a predetermined address database;

resolving the first instance of the incorrect address to determine a correct address by using at least one of a plurality of address resolution processes;

storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address.

According to claim 1, the incorrect address “does not match address information contained in a predetermined address database” (emphasis added), such as, in one embodiment, the ZIP+4 database, as disclosed in the specification at page 14, lines 28-30. For example, an incorrect address may contain “an address with an incorrect or missing ZIP code.” *Id.*, at lines 9-10. Furthermore, according to claim 1, after “resolving the first instance of the incorrect address to determine a correct address by using at least one of a plurality of address resolution processes,” the first instance of incorrect address is stored as part of a resolved address. Applicants submit that neither Allen nor Anchor teaches or suggests an incorrect address that “does not match address information contained in a predetermined address database” or “storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address,” as recited in claim 1.

Allen teaches an apparatus for intercepting and forwarding incorrectly addressed mail pieces. The address on a mail piece is compared with the addresses in the USPS National Change of Address (NCOA) database, which contains the name and former address of each addressee who has filed a change of address form with the USPS, to determine if a forwarding request has been logged. *Id.*, col. 6, line 65 to col. 7, line 4. Allen refers to the address on a mail piece as an “incorrect” address when it is the

“former” address, as opposed to the current address, for the addressee. *Id.*, col. 6, lines 11-19. Allen teaches that an address is categorized as an “incorrect address” if it matches one of the former addresses in the NCOA database. *Id.*, col. 6, lines 47-49; col. 6, line 65 to col. 7, line 21. Thus, the meaning of “incorrect address” as taught by Allen is completely different from “incorrect address” as recited in amended claim 1, which recites that the incorrect address “does not match address information contained in a predetermined address database.” Consequently, because Allen does not teach or suggest an “incorrect address” as recited in claim 1, Allen also does not teach or suggest “storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address,” as recited in claim 1 (emphasis added).

Anchor also does not teach or suggest an “incorrect address” or “storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address,” as recited in claim 1 (emphasis added).

Anchor teaches “a comprehensive master file of all permanent (non-seasonal) residential and business change of address records.” Anchor, p. 2, paragraph 7. Anchor also teaches processing a customer’s lists of addresses and making all necessary address correction to provide the correct addresses. *Id.* However, Anchor contains no teaching or suggestion of storing an “incorrect address,” which “does not match address information contained in a predetermined address database,” as recited in claim 1. Accordingly, Anchor does not cure the deficiencies of Allen. Therefore, even if the teachings of Allen and Anchor were combined, the alleged combination would not arrive at Applicants’ claimed invention. Moreover, neither Allen nor Anchor, in any combination, is capable on the whole of resolving an incorrect address that “does not

match address information contained in a predetermined address database" as recited in claim 1,

For at least the foregoing reasons, Allen and Anchor, whether taken alone or in combination, fail to teach or suggest the recited features of claim 1, and the Office Action incorrectly determined the scope and content of the prior art. Moreover, the undisclosed features represent significant differences between the claimed invention and the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and it is allowable over the cited references. Dependent claims 4-12 are also allowable at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Although of different scope, each of independent claims 13, 25, and 37 includes similar features as those recited in claim 1. For at least the same reasons presented above in connection with the patentability of claim 1, each of independent claims 13, 25, and 37 is patentable over the cited references, and thus, is allowable. Dependent claims 16-25, 28-37, and 40-48 are also allowable at least by virtue of their dependence from independent claims 13, 25, or 37, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claims 1, 4-13, 16-25, 28-37, and 40-48.

#### New Claims

Applicants submit that new claims 57-64 are allowable at least by virtue of their dependence from independent claims 1, 13, 25, or 37, as well as by virtue of reciting additional features not taught or suggested by the cited references.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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